

REMARKS

In the Office Action,¹ the Examiner objected to claims 1, 14 and 18, rejected claims 14, 15, and 17 under 35 U.S.C. § 101, and rejected claims 1-2, 4-15, 17-19 and 21-22 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,055,569 to O'Brien.

Applicants thank Examiner Termanini for telephone interviews on March 20, 2008 and April 18, 2008. In the March 20, 2008 interview, Applicant's representative discussed the claim objections and noted the differences within the claims between the claimed "interface states" and "interface appearances." The Examiner agreed that the objections were not proper, offered to study the applicability of the cited reference to the claim, and also offered to issue a new Office action if he found that the reference no longer applied in light of his interpretation of the claims. No agreement was reached as to a resolution of the status of the rejected claims. No new Office action was issued.

In the April 18, 2008 interview, Applicant's representative and Examiner Termanini discussed the claim objections and rejections under 35 U.S.C. § 101. Examiner Termanini again agreed that the claim objections were improper and would be withdrawn with the next Office action. Examiner Termanini also offered to re-evaluate the 35 U.S.C. § 101 rejection and either withdraw the rejection or provide a more detailed explanation of the rejection with the next Office action. Examiner Termanini again offered to issue a new Office action, but no new Office action was issued.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Though no agreement was reached as to a resolution of the status of the rejected claims, Examiner Termanini agreed that the next Office action would be non-final.

Regarding the objection to claims 1, 14, and 18, the claim portions drawn to “user interfaces appearances” are not improperly repeated in the claims. The claims properly recite “user interface appearances” and “user interface states.” Therefore, the objection is improper and should be withdrawn.

Regarding the rejection of claims 14, 15, and 17 under 35 U.S.C. § 101, Applicants respectfully traverse the rejection. Page 1 of the Specification, at lines 20-21, discloses that “in one aspect, the invention provides methods and apparatus, including computer program products, for rendering the user interface of a software application.” However, neither this portion, nor any other portion of the Specification constitutes an assertion that the Specification discloses an invention that is “software per se.” In addition, claims 14, 15, and 17 positively recite a series of steps or acts to be performed. Therefore, each of the claims rejected under 35 U.S.C. § 101 is drawn to a “method,” which is a statutory category of inventive subject matter under 35 U.S.C. § 101. For at least these reasons, the rejection is improper and should be withdrawn.

Applicants respectfully traverse the rejection of claims 1-2, 4-15, 17-19, and 21-22 under 35 U.S.C. § 102(b) as being anticipated by *O'Brien*. In order to properly establish that *O'Brien* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference.

See M.P.E.P. § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d

628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.”

See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

O'Brien does not disclose each and every element of Applicants' claimed invention. Claim 1 recites a combination of elements including, for example, “pre-render[ing] one or more of the possible user interface states to generate one or more possible user interface appearances . . . and stor[ing] the one or more possible user interface appearances.” The Examiner alleges that “background downloading” of *O'Brien* anticipates this portion of the claim. Office Action, page 7. This is not correct.

O'Brien does not disclose any “pre-rendering,” as it is claimed. Instead, *O'Brien* downloads “links” and “wait[s] for the user to select, typically by the use of the mouse button, another link.” Column 5, lines 9-14. If a “page” associated with a “link” has already been downloaded, it is presented to the client for display. Column 5, lines 14-18. However, before the “page” associated with the “link” is “displayed,” no “user interface appearance” is “generated” or “stored,” as claimed. Therefore, *O'Brien* fails to teach instructions to “pre-render one or more of the possible user interface states to generate one or more possible user interface appearances . . . and store the one or more possible user interface appearances,” as claimed. Therefore, *O'Brien* does not anticipate at least this portion of claim 1.

Because *O'Brien* does not disclose each and every element recited by claim 1, *O'Brien* cannot anticipate this claim, and claim 1 is allowable over the art of record. Claims 2, 4-13 and 22 are also allowable at least due to their dependence from claim 1.

Independent claims 14 and 18, though of different scope from claim 1, recite elements similar to those set forth above for claim 1. Claims 14 and 18 are therefore allowable for at least the reasons presented above with respect to claim 1. Claims 15, 17, 19 and 21 are also allowable at least due to their respective dependence from claims 14 and 18. Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 2, 4-15, 17-19, 21 and 22 under 35 U.S.C. § 102(b).

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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